REMARKS/ARGUMENTS

Claims 1-8 are pending in the present application. Claims 9-20 are canceled. Claims 1, 5, and 8 are amended. Applicants are not conceding in this application that these claims are not patentable over the art cited by the Examiner, as the present claim amendments are only for facilitating expeditious issuance of the application. Applicants respectfully reserve the right to pursue these and other claims in one or more continuations and/or divisional patent applications. Support for the amendments to the claims is located at least on page 3, lines 3-20; on page 9, line 27, through page 10, line 19; on page 11, lines 23-27; on page 13, lines 9-14; on page 16, lines 14-24; and on page 19, lines 1-17. Reconsideration of the claims is respectfully requested.

I. 35 U.S.C. § 102, Anticipation

The Examiner has rejected claims 1, 3-10, 12-15, and 17-20 under 35 U.S.C. § 102(e) as being anticipated by U.S. pre-grant publication number 2005/0043985 to *Gillespie* (hereafter *Gillespie*). This rejection is respectfully traversed.

With regard to independent claims 1, 9, 10, and 15, the Examiner states:

> Claims 1, 9, 10, & 15: Gillespie discloses a method, system (see paragraph 36: lines 31-34 for system components), and computer program product (see id.) in a data processing system for providing a consulting assessment environment, the method comprising:
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> - receiving data about a business through a questionnaire, wherein the questionnaire is defined by a data template (see paragraph 36: lines 10-23, disclosing a survey system to present questions and receive responses regarding a business; paragraph 37, disclosing customizing the survey questions);
> - computing at least one assessment score based on formulas in an assessment framework template (see paragraph 38: lines 1-15, disclosing evaluating responses and generating a score based on the responses; paragraphs 43-51, disclosing specific calculations)
> - determining an appropriate action based on the at least one assessment score and a suggested actions template (see paragraph 38: lines 8-15, disclosing providing the user with a recommendation; paragraph 43); and
> - reporting results based on the at least one assessment score and the appropriate action in accordance with a report template, wherein the assessment framework template and the suggested actions template encode business-related domain knowledge (see paragraph 38: lines 8-30, disclosing reporting results to users; paragraph 52; paragraph 56) including at least one of best practices, business consultant expertise, and business goals (see paragraph 37: disclosing customizing a survey and evaluation based on an administrator's input).

Office Action dated March 25, 2008, pages 3-4.

As amended, independent claim 1 reads as follows:

> 1. A method in a data processing system for providing a consulting assessment environment, the method comprising:
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> receiving data about a business through a questionnaire, wherein the questionnaire is defined by a data template;
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> computing at least one assessment score based on formulas in an assessment framework template;
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> determining an appropriate action based on the at least one assessment score and a suggested actions template; and
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> reporting results based on the at least one assessment score and the appropriate action in accordance with a report template, wherein the assessment framework template and the suggested actions template encode business-related domain knowledge including at least one of best practices, business consultant expertise, and business goals, and wherein proprietary information and trade secrets of the consulting assessment environment are hidden from clients. (emphasis added)

A prior art reference anticipates the claimed invention under 35 U.S.C. § 102 only if every element of a claimed invention is identically shown in that single reference, arranged as they are in the claims. *In re Bond*, 910 F.2d 831, 832, 15 U.S.P.Q.2d 1566, 1567 (Fed. Cir. 1990). All limitations of the claimed invention must be considered when determining patentability. *In re Lowry*, 32 F.3d 1579, 1582, 32 U.S.P.Q.2d 1031, 1034 (Fed. Cir. 1994). Anticipation focuses on whether a claim reads on the product or process a prior art reference discloses, not on what the reference broadly teaches. *Kalman v. Kimberly-Clark Corp.*, 713 F.2d 760, 218 U.S.P.Q. 781 (Fed. Cir. 1983). Applicants respectfully submit that *Gillespie* does not identically show every element of the claimed invention arranged as they are in the claims. Specifically, *Gillespie* does not teach or suggest each and every feature as recited in amended independent claim 1.

Gillespie is directed to systems and methods for evaluating the merits of an opportunity. A survey system having a plurality of survey questions or statements relating to the opportunity is provided to a user. A user responds to the survey. Information relating to the survey questions or statements, evaluation parameters relating to the questions or statements, potential responses, evaluations parameters relating to responses, and information relating to actual responses is stored. The actual responses are evaluated against pre-defined criteria and an evaluation record is generated. At least one user is provided with information regarding the evaluation of the opportunity along with a recommendation relating to the opportunity. See *Gillespie*, abstract. *Gillespie* does not teach or suggest "reporting results based on the at least one assessment score and the appropriate action in accordance with a report template, wherein the assessment framework template and the suggested actions template encode business-related domain knowledge including at least one of best practices, business consultant expertise, and business goals, and wherein proprietary information and trade secrets of the consulting assessment environment are hidden from clients," as recited in amended claim 1.

With respect to the rejection of independent claim 1, the Office Action refers to the following portions of *Gillespie*:

> [0036] Referring now to FIG. 1, a method according to the invention will be described, which is carried out by a system according to the invention, which may be implemented in a computer system, a global information system or other desired manners. The invention will be described with reference to the evaluation of a travel opportunity, which may be prospective or consummated, for an individual or organization. It should be understood that similar embodiments are contemplated for other opportunities, to allow more objective evaluation thereof. The invention embodies the ability to evaluate prospective and consummated opportunities of an organization and relative to aggregated data related to similar types of opportunities of other organizations. The opportunities may vary, and may be personal or organizational, and are not limited to the embodiments as described herein. For example, other opportunities that it would be beneficial to evaluate according to the invention may include investment decisions, resource allocation, purchasing or other capital expenditures, new client or customer qualification or relationships, etc. As seen in FIG. 1, as a first step, the system and method according to the invention provide a survey system for presenting questions and receiving responses from a user at 10. The system according to the invention is capable of facilitating the creation, editing, storing and associating of survey-style questions or statements (hereinafter questions), question weights or other evaluation parameters that may be given to questions, potential responses relevant to each question, response weights that may be given to responses, and actual responses relative to a prospective opportunity, such as a trip and/or traveler. This survey system may be implemented in writing, but preferably via a user interface in a computer system comprising a data input device, a data storage device, a processor and a user interface. As an example, the methods and system could be implemented via the Internet or other global information system, so as to be accessible to a wide variety of users via a Web page or the like. In such an embodiment, a user could access the system via a user code and password to allow the particular information relating to an organization or other entity to be input and accessed.
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> [0037] In the business setting, the survey system may be configured to provide an administrator with the ability to customize the survey questions, the question weights, the potential responses to each question, a weighting or other evaluation parameter associated with each potential response, or to create and edit other aspects of the survey system or systems used for evaluation, comparison or other analysis of the travel information. Such information may include characteristics about 1) the user, such as job function, travel habits, primary reasons for traveling, types of trips taken, number of trips taken, and the like; or 2) the user's organization, such as the organization's industry, its revenues, number of employees, annual travel expenditures, or the like.
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> [0038] Thereafter, at step 12, the system and method evaluates responses received from a user against pre-defined criteria. In an example, the system may be designed to score a user's answers to a set of questions that have been created by the survey system's administrator, using the questions, the question weights, the user's selected responses, and the response weights or other information, which may collectively be referred to as a "trip record". Additional information may be included in the trip record, such as that associated with the user's characteristics and/or the organization's characteristics. Thereafter at 14, the system and method may provide the user or others with information regarding the merits of a travel opportunity, such as a score and/or a recommendation or the like, based upon the evaluation performed using the predefined criteria. Other

> organizations' information may then be aggregated or accumulated and anonymized to allow users to obtain and evaluate travel characteristics of larger related groups or based upon predetermined demographics or the like. The system may be used to store the fields and records relating to the survey questions, question weights, relevant potential responses, response weights, and selected responses for an opportunity. In this embodiment, the user may also or alternatively input travel characteristics for completed travel to facilitate evaluating past trips or other opportunities. The evaluations of prospective travel or past travel may then be communicated to designated users via the Web page and/or via e-mail or other computerized systems to make the survey and results of the surveys available to potential travelers or users, and/or their organization's authorized employees.

Gillespie, paragraphs [0036]-[0038]. (emphasis added)

These portions of *Gillespie* do not teach or suggest that proprietary information and trade secrets of the consulting assessment environment are hidden from clients. *Gillespie* teaches using a set of pre-defined criteria for evaluating a prospective opportunity, such as a travel opportunity. *Gillespie* teaches that the pre-defined criteria may be designed by the user, the system's administrator, the management of an organization or other entity. There is no mention of concealing trade secrets or proprietary information of a consulting assessment environment that may be part of a best practice or business consultant expertise to achieve a business goal for example. *Gillespie* does not teach or suggest "reporting results based on the at least one assessment score and the appropriate action in accordance with a report template, wherein the assessment framework template and the suggested actions template encode business-related domain knowledge including at least one of best practices, business consultant expertise, and business goals, and wherein proprietary information and trade secrets of the consulting assessment environment are hidden from clients," as recited in amended claim 1.

In addition, the Office Action refers to the following portion of *Gillespie* with respect to the rejection of independent claim 1:

> [0043] From the foregoing, a score for the trip record based upon the responses from the user to the survey's questions may be presented to the user as indicated at 14, wherein the rule or recommendation associated with the score is provided to the user. The rule or recommendation may be input by the survey system's administrator or otherwise determined based upon predefined criteria. As seen in FIG. 2, the method and system according to the invention may further comprise the step of scoring or rating a prospective travel opportunity according to the predefined criteria at 20. This score or rating can then be evaluated based upon predefined travel rules or recommendations and communicated to the user and/or the organization's management at 22. The system and method can monitor and/or report the status, score, expected costs and/or other information on prospective travel opportunities to designated individuals at 24. Note that a score or rating can take a quantitative form such as a number or percentage, or a word-based form, such a "Good", "High", "Fairly Acceptable" or the like. In addition, the system may allow for rating or valuing the merits of a particular consummated travel opportunity at 26, and evaluating the merits of consummated travel opportunities at 28.

As an example, and with reference to this example of the invention, the trip record's score may be calculated by:

[0044] 1. Finding the set of questions that the user responded to;

[0045] 2. For each question in this set, find the maximum value of the question's responses as recorded in the Question-Response Table;

[0046] 3. Multiply each question's assigned weight by the maximum value available from the question's responses to derive a Maximum Question-Response Value;

[0047] 4. Sum the values of these Maximum Question-Response Values and use this summed value as the trip record's denominator;

[0048] 5. For each question used in the survey, find the response selected by the user and multiply this response's value by the question's assigned weight to derive a Scored Question-Response Value;

[0049] 6. Sum the values of each scored question-response value, and use this summed value as the trip record's numerator;

[0050] 7. Divide the trip record's numerator value into the trip record's denominator value to obtain the trip record's percentage score.

[0051] Note that there are many possible alternative methods of calculating a trip record's score, such as by using all the questions and their maximum response values as the basis for the score's denominator, regardless of whether a question was answered. Note also that some questions may take the form of multiple-choice answers, wherein adjusting the values of the potential responses for example can accommodate this form of question. Note that the "weight" or evaluation parameter may take the form of points, as illustrated in this example, or the form of a percentage, such that when all the relevant questions are evaluated the sum of their percentages adds to 100%. Other suitable approaches to weighting or providing evaluation parameters for analyzing trip record data are contemplated within the invention. After presenting the trip record's percentage score and preferably the designated scoring message to the user, allow the system to record the user's intention regarding the prospective trip, preferably using an indicator such as "decline the trip" or "decide later" or "accept the trip" or other meaningful indicators of the user's intention about whether or not the trip will be taken. It is contemplated that the user may not be the traveler or the prospective traveler, but may be authorized to access the system on the traveler or prospective traveler's behalf.

[0052] The system and method may also provide for storage of a set of e-mail addresses or other communication information associated with each user, and/or allow the system administrator to designate one or more e-mail addresses as required recipients of selected trip record's details, preferably to include the trip record's score and the user's intention. The trip records selected for required e-mailing may be based on such factors as the user's intention, the trip record's score, the estimated cost of the trip or other such meaningful characteristics of the trip record.

[0056] The system may also allow other functions to be completed as desired for a particular organization or circumstance, such as allowing the user to modify the status of

their recorded prospective trip records, such as changing the trip record's status from "pending" to "declined". In addition, to support the evaluation of the merits of travel opportunities taken at 28, the system may require the user to indicate the value of trips taken, such as by assigning the taken trip a rating or score, such as "very valuable" or "8" on a scale of 1-10. The system may also allow the system administrator or other authorized individuals to query, sort, view and analyze the various trip records stored in the trip record, database. The system may also generate reports that facilitate the monitoring of pending trips, the assessment of the value of trips taken, as well as the value of trips avoided. Examples of such reports may include those identifying 1) relatively expensive trips that scored below a specified level and have not been declined by the prospective traveler; 2) the expected cost of pending trips; 3) the traveler-rated value of trips taken; 4) the estimated cost of declined trips; and other reports using the type of information captured by the system. Example of Management reports and summaries are shown in FIGS. 3A and 3B respectively. One skilled in the art will recognize that these reports are very useful, and yet are merely illustrative of the type of data and method of organization that is possible given the features of this invention.

Gillespie, paragraphs [0043]-[0052] and [0056]. (emphasis added)

These portions of *Gillespie* state that pre-define criteria, such as predefined travel rules or recommendations, are used for scoring or rating a prospective travel opportunity. *Gillespie* teaches that a user is allowed to modify the status of their recorded prospective trip records and that a system administrator or other authorized individuals is allowed to query, sort, view and analyze the various trip records stored in the trip record database. *Gillespie* does not teach or suggest "reporting results based on the at least one assessment score and the appropriate action in accordance with a report template, wherein the assessment framework template and the suggested actions template encode business-related domain knowledge including at least one of best practices, business consultant expertise, and business goals, and wherein proprietary information and trade secrets of the consulting assessment environment are hidden from clients," as recited in amended independent claim 1. In addition, *Gillespie* does not mention proprietary information and trade secrets of a consulting assessment environment or hiding this information from clients.

In view of the above, Applicants respectfully submit that *Gillespie* does not teach each and every feature of independent claim 1, as is required under 35 U.S.C § 102(e). In addition, *Gillespie* does not teach each and every feature of dependent claims 3-8 at least by virtue of their dependency on claim 1. Claims 9-20 are canceled. Accordingly, Applicants respectfully request withdrawal of the rejection of claims 1, 3-10, 12-15, and 17-20 under 35 U.S.C § 102(e).

In addition to being dependent on their respective independent claims, claims 3-8 also distinguish over the *Gillespie* reference based on the specific features recited therein. With respect to amended claim 5, *Gillespie* does not teach or suggest "providing an interface for a client to conduct a self-assessment to gather the data about the business, wherein the data is used to determine a current state of the business, and wherein automated data synthesis is performed to relate the current state of the business to a desired

state in real time." To the contrary, *Gillespie's* survey is directed to an opportunity, such as a travel opportunity, to generate a recommendation, such as whether or not to travel.

In addition, *Gillespie* does not teach or suggest that "the proprietary information and the trade secrets of the consulting assessment environment that are encoded in any of the data template, the assessment framework template, the suggested actions template, and the report template are made inaccessible to the clients," as recited in amended claim 8. As discussed above, *Gillespie* does not mention proprietary information or trade secrets of a consulting assessment environment or hiding this information from clients.

II. 35 U.S.C. § 103, Obviousness

The Examiner has rejected claims 2, 11, and 16 under 35 U.S.C. § 103(a) as being unpatentable over *Gillespie* in view of U.S. pre-grant publication number 2002/0173999 to *Griffor et al.* (hereafter *Griffor*). This rejection is respectfully traversed.

Since claim 2 depends from independent claim 1, the same distinctions between *Gillespie* and the invention recited in claim 1 applies to dependent claim 2. In addition, *Griffor* does not provide for the deficiencies of *Gillespie* with regard to independent claim 1. *Griffor* is directed to computer-based performance management system. *Griffor* is cited for allegedly providing for the deficiencies of *Gillespie* with regard to dependent claims 2, 11, and 16. *Griffor* does not teach or suggest "reporting results based on the at least one assessment score and the appropriate action in accordance with a report template, wherein the assessment framework template and the suggested actions template encode business-related domain knowledge including at least one of best practices, business consultant expertise, and business goals, and wherein proprietary information and trade secrets of the consulting assessment environment are hidden from clients," as recited in independent claim 1. *Griffor* does not mention proprietary information and trade secrets of a consulting assessment environment or hiding this information from clients. Thus, any alleged combination of *Gillespie* with *Griffor* still would not result in the invention recited in claim 1 from which claim 2 depends. Claims 11 and 16 are canceled. Accordingly, Applicants respectfully request withdrawal of the rejection of claims 2, 11, and 16 under 35 U.S.C. § 103(a).

III. Conclusion

It is respectfully urged that the subject application is patentable over the cited reference(s) and is now in condition for allowance.

The Examiner is invited to call the undersigned at the below-listed telephone number if in the opinion of the Examiner such a telephone conference would expedite or aid the prosecution and examination of this application.

DATE: June 25, 2008

Respectfully submitted,

/Gerald H. Glanzman/

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